

RESPONSE TO THE NON-FINAL OFFICE ACTION OF DECEMBER 6, 2004

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Remarks

Rejection under 35 USC§102(b) by U.S. Patent No. 5,647,641 to Sulosky et al.

The patent examiner has rejected claims 1-10, 13-17, 27, 31-34 and 37-38 as being anticipated by Sulosky et al. Applicants respectfully submit that this rejection is without merit and requests the removal thereof and the allowance of the claims.

The Sulosky et al. patent pertains to a road milling drum. This patent does not pertain to a core breaker for use in an underground mining operation. While during examination a claim term is to be given its broadest reasonable construction, applicants submit that such a broad construction, i.e., core breaker is equivalent to a road milling drum, is past the breaking point. Applicants' argument becomes even more persuasive in view of the amendment to claims 1, 27, 31 and 37 that the core breaker is for use with a continuous mining machine wherein the core breaker is mediate of two cutting drums.

For this reason, applicants submit that this rejection lacks merit and request the withdrawal thereof.

Rejection under 35 USC§103(a) by Sulosky et al.

The patent examiner has rejected claims 11 and 12 as being obvious over Sulosky et al. Applicant respectfully submits that this rejection is without merit and requests the removal thereof and the allowance of the claims.

For reasons like those advanced above regarding Sulosky et al., applicants submit that Sulosky et al. is not pertinent to the claimed invention. For this reason, applicants submit that this rejection lacks merit and request the withdrawal thereof.

Rejection under 35 USC§103(a) by U.S. Patent No. 6,315,365 to Gerer et al. in View of Kennametal "Cutting and Drilling Systems"

The patent examiner has rejected claims 18-26, 28-30 and 35-36 as being obvious over Gerer et al. taken in view of the Kennametal publication. Applicant respectfully submits that this rejection is without merit and requests the removal thereof and the allowance of the claims.

Gerer et al. pertains to a mining drum that includes a core breaker that includes bits 4, 5 and 6 wherein each one of these bits is different. In fact, that is one of the important

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aspects of the Gerer et al. invention as described at Column 2, line 54 through Column 3, line 7 of Gerer et al. Further, bits 4 and 5 are stationary and the disclosure of Gerer et al. does not suggest any particular geometry for mounting the bits other than a straight bore. In Gerer et al., the use of the term "parallel shank bit" in connection with the third bit different kind of bit, i.e., bit 6, makes it appear that bit 6 is also stationary, and that bit 6 also does not suggest any geometry other than a straight bore for the mounting thereof¹.

The Kennametal catalog shows a number of different kinds of bits.

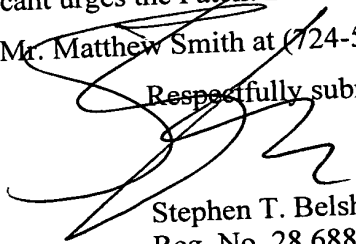
Applicants submit that there is no teaching or suggestion or motivation to combine Gerer et al with any of the bits in Kennametal that show any type of geometry for mounting the bit other than a straight bore. It is only with applicants' invention in mind that one skilled in the art would have even considered geometries along the lines of the claims in distinction to a straight bore. Hindsight is not permissible to us in formulating an obviousness rejection.

Conclusion

Applicant respectfully submits that the pending claims are allowable over the applied references. Applicant respectfully requests the entry of this paper, the removal of the rejections and the prompt issuance of a Notice of Allowability and Notice of Issue Fee Due.

If the Patent Examiner disagrees with the applicant's position, but has suggestions to place claims in form for allowance, applicant urges the Patent Examiner to contact the undersigned attorney (615-662-0100) or Mr. Matthew Smith at (724-539-3848).

Respectfully submitted,


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¹ Applicants' argument about bit 6 is strengthened by the use of the term "parallel shank bit" in reference to U.S. Patent No. 4,669,786 to Morgan (see Col, 1, lines 47-53 of Gerer et al.). Applicants discuss the Morgan patent in the background of the present patent application.